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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,350	12/21/2001	Noriaki Nishi	SON-2552/KOI	3695

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Rader Fishman & Grauer  
1233 20th Street NW Suite 501  
Washington, DC 20036

EXAMINER

PATEL, GAUTAM

ART UNIT	PAPER NUMBER
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2655

DATE MAILED: 03/31/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/914,350

Applicant(s)

NISHI, NORIAKI

Examiner

Gautam R. Patel

Art Unit

2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) 4,6-8,10,11,17,19,20 and 22-52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,9,12-16,18 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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**Response to Amendment:**

1. This is in response to amendment filed on 2-6-04 (Paper # 11).
2. Claims 1-3, 5, 9, 12-16, 18 and 21 remain for examination.

***Election/Restriction***

3. Claims 4, 6-8, 10-11, 13, 17, 19 and 22-52 withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b) as being drawn to figs. Other than 5-9 and 16. Election was made with traverse of claims 1-3, 5-6, 9, 12-16, 18 and 21.

The requirement is still deemed proper and was therefore made **FINAL**.

Applicants are urged to **cancel non-elected claims**.

Applicant is reminded that **upon the cancellation of claims to a non-elected invention, the inventorship must be amended** in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

***Claim Rejections - 35 U.S.C. § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5, 9, 12-16, 18 and 21 are rejected under 35 U.S.C. § 102(b) as being anticipated by Oinoue et al., US. patent 6,044,048 (hereafter Oinoue).

As to claim 1, Oinoue discloses the invention as claimed [see Figs. 2-5] including an objective lens, a light source, light separating means, light detecting means and spot shape correction means, comprising:

an objective lens [fig. 2-3, unit 26] supported for movement [col. 4, line 65 to col. 5. line 25];

a light source [fig. 2-3, unit 21] for radiating a light beam [col. 4, line 65 to col. 5. line 25];

light separating means [fig. 2-3, unit 22-23] for separating the light beam radiated from said light source and a reflected light beam from an optical recording medium from each other [col. 4, line 65 to col. 5. line 25];

light detecting means [fig. 2-3, unit 27] for receiving said reflected light beam from said optical recording medium separated by said light separating means [col. 4, line 65 to col. 5. line 25]; and

spot shape correction means [fig. 2-3, units 22, 25 and 101] arranged between said objective lens and said light detecting means [col. 4, line 65 to col. 5. line 58];

said spot shape correction means correcting part or all of spots formed by said reflected light beam on said light detecting means so that the spot diameter in a direction of traversing a track on said optical recording medium will be larger than the spot diameter in a direction along said track [col. 4, line 65 to col. 5. line 58 and col. 9, lines 44-67];

5. As to claim 2, Oinoue discloses:

said spot shape correction means corrects part or all of said spots formed by said reflected light beam on said light detecting means so that the spot diameter in a direction along the track on the optical recording medium will be approximately minimum [col. 9, lines 27-67].

6. As to claim 3, Oinoue discloses:

said spot shape. correction means includes a cylindrical lens [unit 101] [col. 6, lines 50-55].

7. As to claim 5, Oinoue discloses:  
said spot shape correction means includes a hologram device [col. 5, lines 9-18].
8. As to claim 9, Oinoue discloses:  
said light detecting means for receiving said reflected light beam includes at least one set of light receiving sections, obtained on splitting, and wherein at least one of tracking error signals, address signals and clock signals is obtained by a push-pull method using said light receiving sections [col. 9, lines 63-67 and col. 10, line 42 to col. 11, line 30]..
9. As to claim 12, Oinoue discloses:  
divergence angle converting means [fig. 2-3, unit 23 & 25] for converting an incident numerical aperture to light separating means to a smaller value is provided between said light source and said light separating means [col. 5, lines 4-65].
10. As to claim 13, Oinoue discloses:  
said divergence angle converting means includes a coupling lens [fig. 1, unit 25] [col. 5, lines 4-65].
11. As to claim 14, it is rejected for the same reasons set forth in the rejection of claim 1, supra.
12. As to claims 15-16, 18 and 21, they are claims corresponding to claims 2-3, 5 and 9 respectively and they are therefore rejected for the same reasons set forth in the rejection of claims 2-5 and 9 respectively, supra.
13. Applicant's arguments with respect to claims 1-3, 5, 9, 12-16, 18 and 21 have been considered but are **moot** in view of the new grounds of rejection. As to the arguments regarding 4 and 17, that they should be included in the rejection of Species I.

Art Unit: 2655

First these arguments were presented previously as to why they are NOT species I.  
Second FINAL on the election was given in last office action and final stands.

***Other prior art cited***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Iwamatsu et al. (US. patent 5,805,315) Holographic scanner ..".

**Contact Information**

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is (703) 308-7940. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2650) where this application or proceeding is assigned is (703) 872-9314.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Doris To can be reached on (703) 305-4827.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 305-4700 or the group Customer Service section whose telephone number is (703) 306-0377.



Gautam R. Patel  
Primary Examiner  
Group Art Unit 2655

March 24, 2004